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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,933	02/07/2002	Kayoko Fukasawa	3815/149	9846
29858	7590	05/04/2005	EXAMINER	
BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP 900 THIRD AVENUE NEW YORK, NY 10022			NGUYEN, DAVID Q	
			ART UNIT	PAPER NUMBER
			2681	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,933

Applicant(s)

FUKASAWA ET AL.

Examiner

David Q Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 33-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-32 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date all IDSs.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 1-17 and 33-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions I, II, and III, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/20/04 and stated by Applicants, Adrian Lee on 04/12/05.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 18-20 and 23-32 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakamura et al. (US 6,463,284).

Regarding claim 18, Nakamura et al disclose a switching station comprising means for receiving a location registration signal from a mobile station (see col. 7, lines 13-16 and fig. 17); and means for deleting, when the location registration signal is received, one of pieces of subscriber service information presently registered in a first management unit provided for use with the switching station and managing subscriber information (see col. 7, lines 35-52), and for registering subscriber service information of the mobile station that has transmitted the location registration signal in the first management unit provided for use with the switching station, in a

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case where no subscriber service information can be newly registered in the first management unit provided for use with the switching station (see col. 7, lines 13-16 and lines 35-52).

Regarding claims 19-20, Nakamura et al also discloses means for registering subscriber location information about a mobile station in a second management unit managing subscriber information (see col. 1, line 64 to col. 2, line 4, HLR), and means for receiving subscriber service information about a mobile station from said second management unit (see col. 1, line 64 to col. 2, line 4, HLR), wherein said switching station registers, when the location registration signal is received, subscriber location information about the mobile station that has transmitted the location registration signal in a second management unit managing subscriber information (see col. 1, line 64 to col. 2, line 4, HLR), receives subscriber service information about the mobile station that has transmitted the location registration signal from said second management unit (see col. 1, line 64 to col. 2, line 4, HLR), deletes one of pieces of subscriber service information presently registered in the first management unit provided for use with the switching station (as explained in claim 18), and registers the subscriber service information of the mobile station that has transmitted the location registration signal in the first management unit provided for use with the switching station, in a case where no subscriber service information can be newly registered in the first management unit provided for use with the switching station (as explained in claim 18, VLR); said second management unit is an HLR (see col. 1, line 64 to col. 2, line 4).

Regarding claims 23-24, Nakamura et al also discloses means for receiving a call origination signal from a mobile station (see col. 1, line 64 to col. 2, line 4), and means for acquiring subscriber service information about a mobile station from a second management unit managing subscriber information (see col. 1, line 64 to col. 2, line 10), wherein when the

switching station receives, after deleting one of pieces of subscriber service information presently registered in the first management unit for use with the switching station, a call origination signal and a call termination signal to a mobile station from a mobile station corresponding to the deleted subscriber service information (see explanation in claim 18), the switching station acquires the subscriber service information about the mobile station from the second management unit (see col. 1, line 64 to col. 2, line 4) and, if the acquired subscriber service information cannot be newly registered in the first management unit for use with the switching station, the switching station deletes one of pieces of subscriber service information presently registered in the first management unit, and registers the acquired subscriber service information in the first management unit for use with the switching station (see explanation in claim 18), wherein said second management unit is an HLR (see col. 1, line 64 to col. 2, line 4).

Regarding claims 25-26, Nakamura et al also discloses means for receiving a call termination signal to a mobile station (see col. 1, line 64 to col. 2, line 4), and means for acquiring subscriber service information about a mobile station from a second management unit managing subscriber information (see col. 1, line 64 to col. 2, line 10), wherein when the switching station receives, after deleting one of pieces of subscriber service information presently registered in the first management unit for use with the switching station, a call termination signal to a mobile station from a mobile station corresponding to the deleted subscriber service information (see explanation in claim 18), the switching station acquires the subscriber service information about the mobile station from the second management unit (see col. 1, line 64 to col. 2, line 4) and, if the acquired subscriber service information cannot be newly registered in the first management unit for use with the switching station, the switching

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station deletes one of pieces of subscriber service information presently registered in the first management unit, and registers the acquired subscriber service information in the first management unit for use with the switching station (see explanation in claim 18), wherein said second management unit is an HLR (see col. 1, line 64 to col. 2, line 4).

Regarding claim 27, Nakamura et al also discloses wherein said first management unit is a VLR (see col. 6, lines 13-17).

Regarding claim 28, Nakamura et al also discloses selecting the mobile station wherein said switching station whose subscriber service information is to be deleted, in consideration of at least one of call origination, call terminal, location registration, and power state of mobile station (see col. 4, lines 36-46).

Regarding claims 29-30, Nakamura et al also discloses wherein said switching station selects, as the mobile station whose subscriber service information is to be deleted, a mobile station which has made neither call origination, call termination nor location registration for predetermined period of time, or a mobile station whose power state is off (see col. 4, lines 36-46 and col. 7, lines 13-16 and lines 35-52).

Regarding claim 31, Nakamura et al also discloses wherein said switching station selects the mobile station whose subscriber service information is to be deleted, in consideration of communication state of mobile stations (see col. 4, lines 36-46).

Regarding claim 32, Nakamura et al also discloses wherein said switching station registers, when it registers subscriber service information, the subscriber service information as first type of subscriber service information or as second type of subscriber service information (see col. 7, lines 13-16 and lines 35-52 S1, high-priority subscriber or lower-priority subscriber

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S2), and selects the subscriber service information to be deleted from said first type of subscriber service information (see col. 7, lines 13-16 and lines 35-52).

Regarding claim 40, Nakamura et al disclose a subscriber service information registration the steps of: receiving, at a switching station, a location registration signal from a mobile station (see col. 7, lines 13-16 and fig. 17); and deleting, at the switching station, when the location registration signal is received, one of pieces of subscriber service information presently registered in a first management unit provided for use with the switching station and managing subscriber information (see col. 7, lines 35-52); and registering, at the switching station, subscriber service information of the mobile station that has transmitted the location registration signal in the first management unit provided for use with the switching station, in a case where no subscriber service information can be newly registered is in the first management unit provided for use with the switching station (see col. 7, lines 13-16 and lines 35-52).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al (US 6,463,284) in view of Shepherd et al. (US 6,804,540).

Regarding claim 21, Nakamura et al also discloses means for registering subscriber location information about a mobile station in a second management unit managing subscriber

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information, wherein when the switching station deletes one of pieces of subscriber service information presently registered in the first management unit for use with the switching station (see explanation in claim 18), and wherein when the switching station receives the location registration signal from the mobile station, the switching station registers in the second management unit the subscriber location information about the mobile station registered in the first management unit for use with the switching station (see col. 1, line 63 to col. 2, line 33). Nakamura et al does not disclose the switching station does not delete, from the first management unit for use with the switching station, subscriber location information about a mobile station corresponding to the subscriber service information to be deleted. However, Shepherd et al discloses keep track of all subscribers' location (see col. 3, line 61 to col. 4, line 11). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching to Shepherd et al to Nakamura et al so that the home mobile network will know where to forward a call addressed to the subscriber who is currently outside the home mobile network.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Nguyen whose telephone number is 571-272-7844. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moise Emmanuel can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN

David Nguyen

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